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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/502,701 02/11/00 FOX

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000164 PM82/1106  
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THE KINNEY & LANGE BUILDING  
312 SOUTH THIRD STREET  
MINNEAPOLIS MN 55415-1002

EXAMINER

ROWAN, K

ART UNIT

PAPER NUMBER

3643

DATE MAILED:

11/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/502,701**

Applicant(s)  
**FOX**

Examiner  
**KURT ROWAN**

Art Unit  
**3643**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Newly submitted claim 43 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 43 is drawn to a bucket assembly which has separate utility such as for holding other fishing items such as bait.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 43 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fishing rod and ice fishing tip-up must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: first spacing component, second spacing component.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10 and 27, 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The ice fishing rod having a reel or line wind-up attached to the ice fishing rod near the handle, the pre-rigged ice fishing rods, pre-rigged ice fishing tip-ups are not supported in the original disclosure. See page 3, line 24.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-2, 7-9, 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by

Thibodeaux for substantially the same reasons stated in the first Office Action.

The patent to Thibodeaux shows an ice fishing storage apparatus having a pair of extendable elongate shells 12, 13, 14 having an interior surface that defines an elongate cavity. The shells are located adjacent to each other. The top portion 5 of the container acts as a spacing structure and secures the extendable elongate shells in a predetermined relation to each other.

9. Claims 10-15, 17-18, 30-34, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolniak for substantially the same reasons stated in the first Office Action.

The patent to Wolniak shows an ice fishing and fishing storage device. In reference to claims 10, 30-34, Wolniak shows a pair of elongate shells 30, 30a, each having an interior surface that defines an elongate cavity that ice fishing tackle is capable of being positioned within. Wolniak shows a first spacing component or template 26 having a plurality of interior surfaces that define a plurality of apertures 22 and a second spacing component 21 in Fig. 2. In reference to claim 11, Wolniak shows the ice fishing tackle storage apparatus positioned in a container 10 that has an end wall 12 with an interior surface. The first spacing component is in contact with the interior surface of the wall as shown in Fig. 1. In reference to claim 12, Wolniak shows the second spacing component 21 in contact with the interior surface of the wall 11. Wolniak shows

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apertures or holes 23 in the bottom wall of the container which also can be considered as sockets which are joined to the elongate shells.

10. Claims 19, 21, 22-23, 39, 41 are rejected under 35 U.S.C. 102(b) as being anticipated by McEwen.

The patent to McEwen shows an ice fishing tackle storage apparatus having a plurality of elongate shells 16 having an elongate interior cavity, a spacing structure 20, 20 secured to the shells and a plurality of legs 40, 42 attached to the shells. McEwen shows a container 10.

McEwen shows the elongate shells capable of securing ice fishing tackle therein. The spacing structure 20, 20 is effective to maintain two or more of the elongate shells in predetermined relation with each other proximate the spacing structure. The elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the two elongate shells are positioned in contact with the surface as shown in Fig. 8.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibodeaux as applied to claim 1, above, and further in view of Morin.

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The patent to Thibodeaux shows an ice fishing tackle storage device as discussed above and show one template which is the top surface. Morin shows an ice fishing tackle storage apparatus having a first 14 and second 24 template to hold rod 12. In reference to claim 3, it would have been obvious to employ a second template in Thibodeaux as shown by Morin for the purpose of supporting the fishing rod in two places.

13. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibodeaux.

The patent to Thibodeaux shows a fishing storage apparatus as discussed above. Thibodeaux shows holding fishing rods, but it would have been obvious to hold other related fishing tackle such as tip-ups for ice fishing both pre-rigged or un-rigged since the function is the same. In reference to claim 28, Thibodeaux shows a stop 13-14. It would have been obvious to employ an adjustable stop. See *In re Stevens*, 101 USPQ 284. In reference to claim 29, Thibodeaux does not show a rounded surface at the proximal end of the elongate shell. However, it would have been obvious to a employ a rounded surface for the purpose of easier insertion of the fishing tackle. The examiner takes Official Notice that rounded surfaces are old and well known in fishing tackle storage devices.

14. Claims 1, 4-6, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolniak in view of Thibodeaux.

The patent to Wolniak shows an ice fishing storage device for fishing tackle as discussed above. Wolniak does not show the elongate shells having an adjustable length, but does show tubes of different lengths. Thibodeaux shows adjustable length tubes 12-14. In reference to claims 1, 16,

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it would have been obvious to provide Wolniak with at least one adjustable length tube as shown by Thibodeaux for the purpose of storing fishing tackle of different lengths in one elongate shell. In reference to claims 4, 5, Wolniak shows a top wall 26 with apertures 22 which also can be considered sockets.

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEwen.

The patent to McEwen shows a fishing pole holder and storage container that functions as an ice fishing storage apparatus as discussed above. In reference to claim 20, McEwen does not disclose positioning the ice fishing storage apparatus in a container. However, it would have been obvious to store the elongate shells and the spacing structure in the container when not in use for the purpose of minimizing storage space.

16. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolniak.

The patent to Wolniak shows a fishing tackle storage system as discussed above. In reference to claim 35, it is not clear if Wolniak can store an entire ice fishing tip-up within the chamber, but it would have been obvious to size the chamber to store whatever type and size of fishing tackle desired such as a tip-up so the tip-up can be transported safely to the fishing location. In reference to claim 36, Wolniak does not show a rounded surface on the proximal end of the elongate shell, but it would have been obvious to employ a rounded surface for the purpose of easier insertion of the tackle into the shell. As stated above, the examiner takes Official Notice that rounded surfaces are old and well known on fishing tackle storage devices.



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17. Claims 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEwen as applied to claims 19 and 23 above, and further in view of Wolniak.

The patents to McEwen and Wolniak show fishing tackle storage devices and have been discussed above. In reference to claims 40 and 42, it would have been obvious to provide McEwen with a template as shown by Wolniak for the purpose of storing fishing tackle in the container.

***Response to Arguments***

18. Applicant's arguments filed August 20, 2001 have been fully considered but they are not persuasive. Applicant argues that Thibodeaux does not disclose an extendable series of members. However, Fig. 4 clearly shows an extendable series of members that define an extendable elongate cavity. The term adjacent is relative and the members of Thibodeaux can be considered as adjacent each other since no frame of reference is given. Since the series of members can be mounted in an aperture in the top surface, each of the members can pass through one of the apertures. The cups of Thibodeaux can be considered as tubes that are male and female noting Fig. 4. In reference to claim 10, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the tubes are long enough to store a majority of a fishing rod) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The tubes 30 of Wolniak are joined to the holes 23 by way of the walls 11-12. As to McEwen, as shown in Fig. 8, the tube 16 has part of the bottom portion in contact with the

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ground and can hence are capable of serving as legs that will stably support the apparatus on a surface when the two elongate shells are positioned in contact with the surface.

*Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KURT ROWAN** whose telephone number is (703) 308-2321.

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The examiner can normally be reached on Monday-Thursday  
from 6:30 a.m. to 5:00 p.m.

The fax phone number for the organization where this  
application or proceeding is assigned is (703) 306-4195 or  
(703) 305-3597.

Any inquiry of a general nature or relating to the status of  
this application or proceeding should be directed to the  
receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read "Kurt Rowan". The signature is fluid and cursive, with a checkmark-like flourish at the end.

KURT ROWAN

PRIMARY EXAMINER

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November 5, 2001